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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/005,708	04/24/2000	5839514	VITA-006	3545

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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 04/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

EO 12812-2 "BOZS0006"

Office Action Summary

Application No.

09/484,260 ; 90/004,106

Applicant(s)

GIPSON, THOMAS C.

Examiner

George Suchfield

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3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-9 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11 is/are allowed.
- 6) ☒ Claim(s) 4-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 4-9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification discloses two embodiments of applicant's apparatus and method for injecting and retrieving coiled tubing in a well. For example, a first embodiment is depicted in Figure 1, while a second embodiment is depicted in Figure 7. Claim 4, in line 7, calls for "an injector reel rotatably mounted on said mast", which appears to comprise the first embodiment of Figure 1. Other limitations of the claim, however, i.e., wherein the injector reel is positioned in a second or injecting position "above said front end of said frame, and said coiled tubing exits said apparatus at an angle less than 90° to said surface", appear based on the second embodiment, particularly as illustrated in Figures 7 and 9.

Accordingly, if claim 4 is drawn to the first embodiment, it is deemed non-enabling relative thereto because the injector reel in the injecting or second position would be over the rear end of the frame, rather than the front end, and does not appear to depict an angle to the surface of less than 90°. Alternatively, if claim 4 is intended to be drawn to the second embodiment, then it is deemed in conflict therewith because Figure 9, depicting such second embodiment, requires the injector reel to be mounted or attached on the frame (12), rather than the mast (38).

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Claims 5-9 are similarly rejected as they depend from claim 4.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 4-7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by the Vita Brochure.

The Vita Brochure depict the overall structure of coil tubing injector including a frame with a front and back end (note the illustrations on page 4 of the Vita Brochure) and both an injector reel and a coil tubing storage spool or reel. The photographs, e.g., on pages 2 and 3 of the Brochure, clearly illustrate the tubing storage reel removably mounted on the back end of said frame, a mast pivotally mounted on the frame, and an injector reel rotatably mounted on the mast wherein the injector reel is pivotable between a stored position at the front end of the frame to a second tubing injection position located above the frame. The Vita Brochure appears to further provide a drive mechanism to rotate the injector reel. In this regard, note again the illustrations on page 4 of the Vita Brochure, and also the reference to a “Drive” under the coiled tubing injector unit specifications. With respect to the hold down assembly recited in claim 4, the pictures and illustrations of the Vita Brochure (note pages 3 and 4) clearly illustrate the coil tubing injector reel having an assembly of “multiple adjusted tensioned rollers” for exerting

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pressure on the coil tubing, and which is mounted over “more than 90o of the circumference” of the coil tubing injector reel, as recited. Also with regard to claim 4, in the photograph on page 2 of the Vita Brochure labeled “Dual Units Killing Steam Well Without Wellhead”, the coil tubing injector unit pictured on the right appears to show the injector reel in a second or operating position wherein the coil tubing exits the injector reel “at an angle less than 90o to said surface”, as called for in claim 4.

As per claim 5, the photographs of page 1 and page 3 labeled “CTU on Location in Japan” of the Vita Brochure appear to indicate the first tubing stabilizer and second tubing stabilizer, as recited. Note particularly the photograph on page 3 appears to depict two distinct, i.e., upper and lower coiled tubing stabilizers.

As per claim 6, the picture on page 2 of the Vita Brochure labeled “Storage/Work Reel in Traversing Position” depicts a tubing storage spool cradle having pictured opposed pivotable bullnose arms for the tubing storage spool.

As per claim 7, said pictured opposed pivotable bullnose arms appear adjustable in a horizontal direction, i.e., normal to the axis of the frame, due to the hydraulic cylinder and telescoping tubing sections depicted comprising a front portion of the tubing storage spool cradle or frame.

As per claim 9, insofar as the drive mechanism pictured in the Vita Brochure and described on page 4 of the Vita Brochure as a “sprocket & chain final drive”, it would inherently be adjustable, as recited, e.g., by removing or adding links in the drive chain.

5. Claim 8 would be allowable if rewritten to overcome the rejection(s) under 35

U.S.C. 112, first paragraph, set forth in this Office action and to include all of the limitations of

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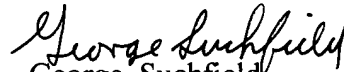
the base claim and any intervening claims, because the Vita Brochure or prior art of record does not appear to depict opposed pivotable bullnose arms which are "vertically slidably attached" to the coiled tubing apparatus frame or tubing storage cradle, as recited in claim 8. The Vita Brochure or prior art of record similarly is not deemed to teach or disclose the limitation in claim 11 wherein a tubing storage spool is mounted on a cradle "vertically and horizontally adjustable to accept varying spool widths and diameters", as recited.

6. Claim 11 is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Suchfield whose telephone number is 703-308-2152. The examiner can normally be reached on M-F (6:30 - 3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 703-308-2151. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.


George Suchfield
Primary Examiner
Art Unit 3672

Gs/Suchfield
April 14, 2003

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